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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,454	12/12/2000	Koji Kuchiishi	33193	8594

7590 08/04/2003
Pearne Gordon McCoy & Granger
1200 Leader Building
Cleveland, OH 44114

EXAMINER

CHIANG, JACK

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 08/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719454

Applicant(s)

K. Kuchiishi et al.

Examiner

J. Chiang

Group Art Unit

2642

6

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 7-03-03
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-7 is/are pending in the application.
- Of the above claim(s) 7 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-6 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ ☐ Interview Summary, PTO-413
- ☒ Notice of References Cited, PTO-892 ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 ☐ Other _____

Office Action Summary

RESTRICTION

1. The restriction dated on 5-29-03 is made final. Claims 1-6 are examined, claim 7 is withdrawn from further consideration.

CLAIMS

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshihiro (JP 08009448 A).

Regarding claim 4, Yoshihiro shows a portable telephone unit (1) comprising:

Soft material (41, 42) that protrudes more than hard material (3, 4) formed on surfaces of upper and lower cases formed of the hard material.

Regarding claim 6, Yoshihiro shows a portable telephone unit (1) comprising:

Soft material (41, 42) which covers a grip portion of upper and lower cases (3, 4).

Regarding claim 5, Yoshihiro shows convexities (see corner areas).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihiro (JP 08009448 A) in view of Yasui (JP 10-244557).

Regarding claim 1, Yoshihiro shows a portable telephone unit (1) comprising:

A waterproof rib and groove (11-12) formed on a soft material provided on the periphery of a joint surface of upper and lower cases formed of the hard material.

Yoshihiro differs from the claimed invention in that it does not explicitly show that the waterproof rib and groove are integrally formed with the cases.

However, the court has ruled that to make prior art parts integral or separable does not constitute patentable weight (*In re Larson* 144 USPQ 347, CCPA 1965; *Nerwin v. Erlichman* 168 USPQ 177). Further, Yasui teaches providing a concept of integrally

forming a waterproof elastomer with a cover which is usually formed of a hard material.

Hence, it would have been obvious for one skilled in the art to integrally form Yoshihiro's waterproof rib/groove with the cases as taught by the law cases or Yasui, because the concept of providing such waterproof rib/groove is well taught by Yoshihiro, and the modification would also eliminate the step of physically installing the waterproof rib because they are now the integral part of the cases (see ABSTRACT in Yasui).


Regarding claims 2-3, the combination of Yoshihiro and Yasui shows:

The fan-shaped waterproof rib and groove (11-12).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Chiang whose telephone number is 703-305-4728. The examiner can normally be reached on Mon.-Fri. from 8:00 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-308-6306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.


Jack Chiang
Primary Examiner
Art Unit 2642